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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/899,322

07/05/2001

Romuald Gaston Corbau

PC10927A

2137

7590

10/06/2003

EXAMINER

SAEED, KAMAL A

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New York, NY 10017-5755

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/899,322	CORBAU ET AL.	
	Examiner	Art Unit	
	Kamal A Saeed	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 76-95,99,101-104 and 151-179 is/are pending in the application.
- 4a) Of the above claim(s) 151-179 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 76-95, 99 and 101-104 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

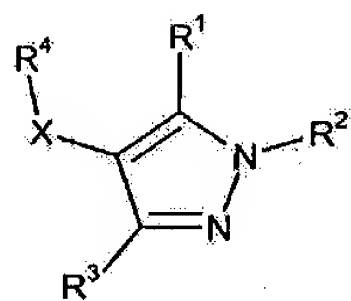
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|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

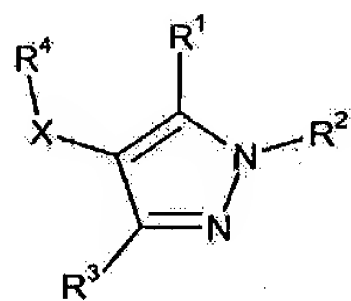
DETAILED ACTION

Claims 96-98, 100, and 119-150 have been cancelled by Amendment filed on 07/28/2003. Claims 76, 99 and 151 have been amended and claims 153-179 added by an amendment filed on 07/28/2003. Therefore claims 76-95, 99, 101-104, 151-179 are pending in this application. The newly added claims, 153-179, drawn to method of use are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Status of the Claims

The scope of the elected invention, as described in the Office Action mailed on January 27, 2003, is as follows:



Compounds of Formula Ib, , wherein: **R¹** is as defined except that it is not further substituted by heterocyclic group; **R²** is Y-Z; **R³** is as defined; **R⁴** is dichloro substituted phenyl; **R⁵** is as defined; **R⁶** is four to six-membered aromatic, partially saturated or unsaturated non-heterocyclic group; **R⁷-R¹¹** are as defined; **X** is as defined; **Y** is a direct bond or C₁-C₆ alkylene; **Z** is as defined.

As a result of the election and the corresponding compounds identified supra, the remaining subject matter of claims 76-95, 99, 101-104 and the newly added claims directed to method of use as stated previously (in Office Actions mailed March 19, 2003) are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions.

The compounds, which are withdrawn from consideration as being non elected subject matter, differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups which differ from those of the elected invention such pyridazinyl, pyrimidinyl, morpholine, thiazine, group etc. This recognized chemical diversity of the functional groups can be seen by various classification of these functional groups in the US classification system i.e. class 544 subclass 106+ (morpholine), class 544 subclass 3+ (thiazine), class 544 subclass 224+ (diazine) etc. Therefore, the compounds, which are withdrawn from consideration as being for non elected subject matter, differ materially in structure and composition and have been restricted properly as a reference, which anticipated, but the elected subject matter would not even render obvious the non-elected subject matter.

Applicant's claim involves more than one independent or distinct invention . Under 35 U.S.C. 121, the claims may be restricted and the examination limited to the restricted invention. Accordingly, restriction as has been presented in this application is proper. The requirement to restrict is repeated and made Final.

Response to Amendment

Applicants Amendment filed on July 28, 2003 have been considered, but are not able to overcome the objection of claims 76-95, 99, 101-104 for having compounds directed to non elected subject matter.

Objections

Claims 76-95, 99, 101-104 remain objected to for containing compounds directed to non-elected subject matter as stated in the previous Office Action.

Therefore **THIS ACTION IS MADE FINAL** . Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.


When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Art Unit: 1626

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D
September 25, 2003



Joseph K McKane,
Supervisory Patent Examiner
Art Unit 1626, Group 1626
Technology Center 1